



AF/3711

Case 7021

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
Owen M. PATTERSON :
Serial No.: 09/977,331 :
Filed: October 16, 2001 :
For: GOLF PUTTING PRACTICE DEVICE :

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TECHNOLOGY CENTER R3700

REPLY BRIEF

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Honorable Commissioner of Patents
and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The paper is responsive to the Examiner's Answer mailed February 10, 2004 and as provided for under 37 CFR §1.193(b)(1).

It is noted the rejection of defendant claims 4, 5 and 21 is now withdrawn.

1. At the bottom of page 3 and at the top of page 4 of the Examiner's Answer, the examiner misstates appellant's reasons for why Wagner is not an anticipatory reference. Appellant does not argue Wagner is not anticipatory because it is intended to be used for a different purpose.

The test for whether a reference is sufficiently "enabled" for purposes of anticipation has been set forth by the Federal Circuit in the *In re Donohoe* decision. It is as follows. Would a person of ordinary skill in the *practice putting art* combine the *description* of the Wagner capture disc with his *own knowledge* of the practice putting art and thus place the public in possession of the claimed target? Wagner only enables for a capture disc that is vertically aligned as shown in the front elevational view of figure 4 and in the top plan view of figure 2. Wagner only enables for using the capture disc with other capture discs as evidenced by the cited art (Tucek) in Wagner. When viewed by one of ordinary skill in the practice putting art, this disclosure fails to place the public in possession of the claimed putting target. Wagner is not enabled as an anticipatory reference because (1) it does not enable for placing the capture disc on its side and (2) it does not enable for using a single capture disc by itself without additional capture discs.

2. The examiner is mistaken in asserting at the bottom of page 3 of the Examiner's Answer and at the top of page 4 that Casey and Otto support the rejection. In those decisions, the CCPA affirmed an *obviousness* rejection where applicant argued the differences in the utility of the claimed invention and the prior art were nonobvious. Appellant makes no such argument in

connection with this appeal nor is an obviousness rejection being applied against claims 1, 2, 6, 7 and 19. The decisions are not relevant to the rejection.

3. In the first full paragraph on page 4 of the Examiner's Answer, the examiner now states *In re Donohoe* is not relevant because Wagner has previously met the requirements of 35 U.S.C. 112, first paragraph for purposes of enablement. The examiner appears to make the argument that appellant has not previously challenged the patentability of Wagner under 35 U.S.C. Section 112, first paragraph, therefore the reference is enabled for purposes of anticipation.

The examiner is confusing enablement for patentability under 35 U.S.C. Section 112 with enablement for anticipation under *In re Donohoe*. A patentability statute is not relevant to an anticipation rejection.

4. In the second to the last paragraph on page 4 of the Examiner's Answer, the examiner argues the capture disc of Wagner is not disclosed as part of a set on an axle but in and of itself as a separate element.

Wagner discloses a vertically aligned capture disc as shown in the front elevational view of figure 4 and in the top plan view of figure 2. Wagner discloses the capture disc grasps a golf ball between adjacent discs. See Tucek cited in Wagner. The examiner

has previously conceded the figure descriptions in Wagner enable for a capture disc of the type used on a golf ball harvesting and retrieving assembly. See Interview Summary Record dated November 19, 2002.

The examiner cannot ignore relevant disclosure in Wagner teaching the correct alignment of the disc and operation of the disc. Wagner does not enable for placing the capture disc on its side or using a single capture disc by itself without additional cooperating capture discs.

5. In the last paragraph on page 4 of the Examiner's Answer, the examiner states *Schreiber* supports the *Casey* decision.

Both the prior art and the invention in *Schreiber* were dispensers (oil and popcorn respectively) and the court found the prior art oil dispenser enabled for use as a popcorn dispenser because nothing in the disclosure of the prior art oil dispenser suggested it was limited to dispensing oil. These facts are quite different from the present case.

Nothing in the disclosure of Wagner suggests it is capable for use as anything other than to capture golf balls between adjacent, vertically disposed discs. Wagner is not enabled for a putting practice disc any more than applicant's device is enabled for use in connection with a golf ball harvester.

6. In the first paragraph on page 4 of the Examiner's Answer, the examiner rebuts appellant's argument that Wagner fails

to disclose an annular outwardly extending member forming in cross-section a substantially truncated conical configuration that is substantially flat as recited in claims 1 and 2. The examiner attaches a copy of the Wagner drawings and adds pair of parallel lines onto figure 6 with the region between the lines labeled as "truncated cone".

A truncated conical configuration in cross-section is a cone having its vertex cut off by a plane. Figures 1 and 2 of appellant's disclosure illustrate the cross-section of annular outwardly extending ring member 18 having a truncated surface 22 that is substantially flat. Also see page 6, lines 17-19 of appellant's specification. As is apparent, there is no such truncation surface in Wagner. The examiner cannot modify Wagner to read on appellant's claims. The error of this rejection is so apparent, it requires no further explanation.

7. In the second paragraph on page 4 of the Examiner's Answer, the examiner responds to appellant's argument that Wagner fails to disclose a top portion and bottom portion that are mirror images as provided in claim 17.

Figures 1 and 2 of appellant's application show a top portion 2 and a bottom portion 4 that are mirror images. The top and bottom of Wagner are not mirror images. The examiner appears to make the argument that because applicant has only claimed a top portion and bottom portion, the interconnection elements extending from the top and bottom of Wagner are irrelevant. The top portion

2 and the bottom portion 4 of the appellant's device are mirror images so that either portion may support the device if it is turned over. Attention is directed to appellant's specification, page 5, lines 9-12. This is not possible with the Wagner capture disc. The Wagner device does not disclose mirror images as claimed.

8. On page 5 of the Examiner's Answer, last two lines, the examiner refers to claim 22 and states the rejection is proper because appellant claimed no particular dimensions for a golf hole and such are provided in various sizes. The examiner states that absent unexpected results, the claimed dimensions would have been unobvious (sic).

Claim 22 states the practice device has a diameter less than the size of an actual cup on a putting green by about the diameter of a standard golf ball. Page 5, lines 3 and 4 of appellant's specification state the diameter of the device may be 2.68 inches. As is apparent, the device is constructed in a manner to correspond with a standard hole on a putting green. Even the most casual observer understands a hole on a putting green has a prescribed diameter and is not "provided in various sizes" as stated by the examiner. Further, the burden to prove unexpected results is only shifted to applicant after the examiner has established *prima facie* obviousness. In this case, the examiner has failed to do so.

9. The nonobviousness arguments in the Appeal Brief at pages 13-15 concerning claims 10-16, 18 and 19 have not been specifically addressed in the Examiner's Answer.

The examiner does make several vague statements without mentioning specific claims on page 5 of the Examiner's Answer. The "exact dimension" of Wagner is found to have been dependant on the "durability desired" and the "number of golf balls" one wished to collect in a single pass. The angle of the so-called Wagner "cone" and the "specific dimensions" of the device are found to be based upon how a golf ball would be "picked up" and are stated to be "in the range" claimed by applicant. Applicant has previously addressed these arguments, which appear to relate claims 10-16, 18 and 19, within their Appeal Brief on pages 13-15 as noted above.

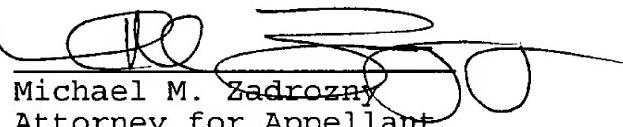
Appellant has the following additional comments concerning these statements. First, *prima facie* obviousness has not been established regarding any of the claims reciting weight, height, width or angle. The dimensions and weight of the claimed device control the degree of tilt as it is struck by a golf ball. Wagner is an ornamental design for a capture disk of a golf ball harvester. One of ordinary skill in the practice putting art would not be motivated to remove a disc from a harvesting machine and change the height, width, weight and angle of that disc so that it will tilt after being struck by a golf ball. Second, variation of the durability and the golf ball lifting rate of the harvester disc has no relation to the height, width, angle, weight and diameter of

the claimed putting practice disc. The claimed features concern tipping ability, not durability or lifting ability.

In view of the above, appellant respectfully submits the reasons provided in the Examiner's Answer are incorrect and/or improper. It is requested the final rejection of the claims be reversed in all respects.

Respectfully Submitted,

Date: APRIL 9, 2004


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